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08/377,450 01/24/95 HOGE

D 1411.0210001  
EXAMINER

KORZUCH, W

ART UNIT PAPER NUMBER

16

ESM1/0325

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2512

DATE MAILED:

03/25/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 11/30/95 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____   |

Part II SUMMARY OF ACTION

1. ☒ Claims 1, 3-5, 7-9, 11 & 12 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1, 3-5, 7-9, 11 & 12 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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***Claim Rejections - 35 USC § 103***

1. Claims 1, 3, 4, 9, 11 and 12 are rejected under 35 U.S.C. § 103 as being unpatentable over Shimizu et al in view of Godsoe et al and further in view of Applicant's admitted prior art as shown on page 8, lines 18-27 for the reasons set forth in the Office action dated May 30, 1995.
2. Claims 5, 7 and 8 are rejected under 35 U.S.C. § 103 as being unpatentable over Shimizu et al in view of Godsoe et al and Applicant's admitted prior art as shown on page 8, lines 18-27 and further in view of Moy et al for the reasons set forth in the Office action dated May 30, 1995.

***Response to Amendment***

3. Applicant's arguments filed on November 30, 1995 have been fully considered but they are not deemed to be persuasive.

Applicant asserts on page 6, "the evidence (i.e. of commercial success) properly rebuts any *prima facie* showing of obviousness presented in the Office Action, or any other plausible argument based on the art of record."

The Examiner maintains that objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971). In order to be commensurate in scope with the

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claims, the commercial success must be due to claimed features, and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 255, 17 USPQ2d 1257, 1260 (D.D.C. 1990), aff'd, 959 F.2d 226, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992). Applicant states that "extraordinary commercial success and industry acceptance of the Redwood is not the results of heavy promotion or advertisement, market demands, or any other extraneous business, but rather is materially attributable to the merits of the claimed invention (i.e., a *helical scan transport* for a *single reel tape cartridge* with the *form factor* feature)." However, claims 1, 3, 4, 9, 11 and 12 do not even recite the form factor feature and therefore the evidence of commercial success is not seen to be commensurate in scope with the claims. Claim 5 recites a transport with a helical head that is dimensioned to fit in an enclosure that is twelve and one-half inches wide by twenty-six and one-half inches deep. Shimizu et al in view of Godsoe et al and further in view of Applicant's admitted prior art shows all the features except for the dimensions of the enclosure that receives the transport. However, the dimensions are seen to be an obvious result of routine space optimization and downsizing. The dimensions do not specify a device that performs or operates differently with respect to the prior art of record. *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984).

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4. The declaration under 37 C.F.R. § 1.132 filed on November 30, 1995 is insufficient to overcome the rejection of the claims as set forth in the last Office action for the reasons set forth above.

**Conclusion**

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Korzuch whose telephone number is (703) 305-6137.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

*William R. Korzuch*  
William R. Korzuch

March 14, 1996

*Stuart S. Levy*  
STUART S. LEVY  
SUPERVISORY PATENT EXAMINER  
GROUP 2500